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09/264,464 03/08/99 BLACH

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EXAMINER

DAWSON, G

ART UNIT

PAPER NUMBER

3761

DATE MAILED:

05/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.  
09/264,464

Applicant(s)

Blach et al

Examiner  
Glenn Dawson

Art Unit  
3761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 20, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-19, and 21-23 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-19, and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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***Continued Prosecution Application***

The request filed on 02-20-01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09.264,464 is acceptable and a CPA has been established. An action on the CPA follows.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-4 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Muchin-5718224.

Muchin discloses in fig. 10b a nasal dilator having the claimed dimensions as it is basically oval in shape. As shown in fig. 10b a central band having the axis in it's middle would have a longer dimension than any other lateral dimension. The same can be said for a vertical column extending across most of the width.

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Sawyer-1292083.

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Sawyer discloses a nasal dilator having a central bridge 7 releasably attached to two side pieces 6.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8,10,11,13-16 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muchin-'224 in view of Johnson-'499.

Muchin discloses the invention substantially as claimed with the exception of the holes through the surface and adhesive layers and the multiple support members. As shown by Johnson, two lift members in a nasal support device were well-known at the time of the invention. It would have been an obvious design choice to have provided a plurality of the support members as this is a mere duplication of known parts.

**DUPLICATION OF PARTS**

In re Harza , 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water - tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a "web" which lies perpendicular to the workface and in the joint, and a plurality of "ribs" which are parallel to the workface, forming the following shape.

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As for the holes, it was well-known at the time of the invention that Band-aids(adhesively affixed skin coverings) to place breathing holes through the surface and adhesive layers of the structure. It would have been obvious to have placed breathing holes through the surface and adhesive layers of Muchin's adhesively attached nasal dilator, as this has been shown to allow the skin under the adhesive patch to breathe.

As for the claimed dimensions, to make a nasal dilator about 4 in. in length would be obvious, as noses come in different sizes, and manufacturing one which would fit individuals with large noses would be an obvious design choice.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitra et al-5890486 in view of Sawyer-'083.

Mitra discloses the invention as claimed with the exception of the central bridge being integral with the side pieces. Sawyer discloses a central portion of a nasal dilator removably coupled to the portions overlying the nasal passages. It would have been an obvious design choice to have separately made the three(3) main pieces of the nasal dilator of Mitra and then provided a well-known attachment means to attach them together on the face of the user as it was well known at the time of the invention that making integral parts separable was obvious.

#### MAKING SEPARABLE

In re Dulberg , 289 F.2d 522, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were

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considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.").

It would be desirable to be able to remove and replace the various components of the device in the event that any of them lost their ability to stay adhesively attached to the skin, or in the event that a central bridge portion with a particular design thereon(as was known in the art) could be chosen to replace the bridge portions presently in use without having to replace all three elements.

As Velcro was a well-known attachment mechanism at the time of the invention, its use to attach the three components together would have been obvious.

Claims 10,11,13-16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalt-5755232.

Kalt discloses the invention as claimed with the exception of the specific size of the device. Kalt in coil. 2 lines 59-62 discloses that the device can be manufactured to be used on much larger areas of the body. Therefore to have made the support member of Kalt in the claimed size range would have been an obvious design choice in order to allow it to be useful for supporting the tissue areas disclosed by Kalt.

### ***Response to Arguments***

Applicant's arguments filed 02-20-01 have been fully considered but they are not persuasive.

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As pointed out in the Mitra 103 rejection, the examiner considers it obvious to make the integral dilator of Mitra into a modular system with separable components for the reasons noted above. The examiner is not relying on his own knowledge, but rather on court cases, one of which is cited in the last office action. The examiner considers it obvious to make previously integral components separably assembled to allow for disassembly to dispose of parts of the device without disposing of the entire device.

The examiner pointing out that the Muchin dilator is oval in shape was done to emphasize that an oval shape meets the claim limitations. Side portions of the oval in each direction are shorter in length than either central dimension running along either axis of the oval. Clearly this would also provide the claimed mirror images of the surface layer.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Glenn Dawson at telephone number (703) 308-4304. Examiner Dawson can normally be reached on Monday through Thursday from 7:00 AM to 5:30 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, examiner Dawson's supervisor, John Weiss, can be reached at (703) 308-2702. The fax number for Group 3300 is (703) 305-3590 or 3591.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 3300 receptionist at (703) 308-0858.

GKD  
May 1, 2001

  
GLENN K. DAWSON  
PRIMARY EXAMINER